

REMARKS

Reconsideration of this application, as amended, is respectfully requested. The Applicants wish to draw the Examiner's attention to the applicants' related co-pending applications and issued patents (see Appendix A) directed to nanoparticles and methods of preparation and use thereof.

The Applicants note that the Examiner did not return an executed PTO 1449 form for the 6th Supp. IDS that was hand-delivered to the Examiner on September 9, 2002. Subsequent to the issuance of this Office action, the Applicants had filed a 7th Supp. IDS. The Applicants request that the Examiner fully execute the PTO 1449 forms for the 6th and 7th Supp. IDS and return a copy of the executed PTO 1449 forms to the undersigned representative. Copies of the initial IDS, 6th and 7th Supplemental IDS, and associated PTO 1449 forms are attached. The Examiner is requested to contact the undersigned representative if the Examiner would like to have another copy of the references.

The specification has been amended to update the priority claim. No new matter has been added to the application as a result of this amendment.

Claims 125-129 and 156 were originally pending in this application. Claims 125-129, 156, and 157 were cancelled, claims 158-161 were amended, and new claims 433-465 were added. The Examiner had indicated that claims 129 and 157 were allowed. As the Examiner will note, these claims were cancelled and reintroduced as new claims 464 and 465, respectively. The amended and new claims are fully supported in the previously pending claims, and thus do not constitute new matter. The amended and new claims are supported, for example, by the original claims and the specification at page 48, line 12 to page 50, line 2; and page 77, line 1 to page 80, line 27. Accordingly, no new matter has been introduced into the application as a result of the above amendment. Claims 158-161 and 433-465 are now pending in this application.

Turning to the office action, claims 128 was rejected under 35 U.S.C. section 112, second paragraph, for indefiniteness. Claims 125, 126 and 156 were also rejected for obviousness-type double patenting as being unpatentable over claims 31 and 33 of U.S. Patent no. 6,506,564. The aforementioned claims were cancelled and thus the aforementioned rejections are moot. Claims 125-128, 156, and 158 stand rejected under 35 U.S.C. section 102(e) as being anticipated by

Yguerabide (U.S. Patent No. 6,214,560)("Yguerabide"). The Applicants respectfully traverse this rejection.

As a general rule, for prior art to anticipate under section 102, every element of the claimed invention must be identically disclosed in a single reference. Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q.2d 1962, 1965 (Fed. Cir. 1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a reference is enough to negate anticipation. Connell v. Sears, Roebuck & Co., 220 U.S.P.Q 193, 1098 (Fed. Cir. 1983). Applicants respectfully submit that Yguerabide cannot be applied to support an anticipation rejection of the new claims under 35 U.S.C. section 102(e).

Specifically, the Examiner alleged that Yguerabide taught detection and measurement of one or more analytes in a sample using particles of specific composition and size using light scattering. The discussion is found starting in col. 82, line 35, of Yguerabide. Col. 83 provides further discussion regarding particle size and particle binding to a surface. There is no discussion of any aggregate probe or method of use thereof. Aggregate probes including two or more types of nanoparticles have been found to be surprisingly useful in target nucleic acid detection assays because they eliminate the need for buildup of multiple layers of individual nanoparticles in order to obtain or enhance a detectable change resulting from the binding of a nanoparticle oligonucleotide conjugate to a target nucleic acid. See the specification at page 49, line 6-page 50, line 2. Furthermore, new claims 433-465 recites limitations that are neither taught, made obvious, or suggested by the cited reference. Thus, the Applicant respectfully submits that Yguerabide cannot be applied to support a section 102(e) rejection of the new claims.

In conclusion, the Applicants respectfully submit that the claims in this application are in allowable condition and request a Notice to this effect.

Reconsideration of this application is respectfully requested and a favorable determination is earnestly solicited. The Examiner is invited to contact the undersigned

representative if the Examiner believes that this would be helpful in expediting the prosecution of this application.

Respectfully submitted,



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APPENDIX A

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
00-653-A	U.S. 09/927,777 Filed 8/10/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garamella, Li, Park/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	PENDING
00-713-B1	09/923,625 Filed 8/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	PENDING
00-713-C	09/344,667, filed 6/25/99	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,361,944, issued 3/26/02
00-713-I	U.S.S.N 09/603,830 Filed 6/26/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	U.S. Patent No. 6,506,564, issued 1/14/03
00-713-I-1	09/961,949 9/20/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton;	U.S. Patent No. 6,582,921, issued June 24, 2003

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFOR	
00-713-I-2	09/957,318 9/20/01	See 00-713-I-1	PENDING
00-713-I-3	09/957,313 9/20/01	See 00-713-I-1	ALLOWED
00-713-I-4	09/966,491 9/28/01	See 00-713-I-1	U.S. Patent No. 6,610,491
00-713-I-5	09/966,312 9/28/01	See 00-713-I-1	ALLOWED
00-713-I-6	09/967,409 9/28/01	See 00-713-I-1	PENDING
00-713-I-7	09/974,500 10/10/01	See 00-713-I-1	PENDING
00-713-I-8	09/974,007 10/10/01	See 00-713-I-1	PENDING
00-713-I-9	09/973,638 10/10/01	See 00-713-I-1	PENDING
00-713-I-10	09/973,788 10/10/01	See 00-713-I-1	ALLOWED
00-713-I-11	09/975,062 10/11/01	See 00-713-I-1	ALLOWED
00-713-I-12	09/975,376 10/11/01	See 00-713-I-1	PENDING
00-713-I-13	09/975,384 10/11/01	See 00-713-I-1	PENDING
00-713-I-14	09/975,498 10/11/01	See 00-713-I-1	ALLOWED

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
00-713-I-15	09/975,059 11/11/01	See 00-713-I-1	PENDING
00-713-I-16	09/976,601 10/12/01	See 00-713-I-1	PENDING
00-713-I-17	09/976,968 10/12/01	See 00-713-I-1	PENDING
00-713-I-18	09/976,971 10/12/01	See 00-713-I-1	ALLOWED
00-713-I-19	09/976,863 10/12/01	See 00-713-I-1	PENDING
00-713-I-20	09/976,577 10/12/01	See 00-713-I-1	ALLOWED
00-713-I-21	09/976,618 10/12/01	See 00-713-I-1	PENDING
00-713-I-22	09/981,344 10/15/01	See 00-713-I-1	PENDING
00-713-I-23	09/976,900 10/12/01	See 00-713-I-1	PENDING
00-713-I-24	09/976,617 10/12/01	See 00-713-I-1	PENDING
00-713-I-25	09/976,378 10/12/01	See 00-713-I-1	PENDING
00-713-i-26	10/410,324 04/10/03	See 00-713-I-1	PENDING
00-713-L	U.S.S.N. 09/693,005 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND	U.S. Patent No. 6,495,324, issued 12/17/02

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		USES THEREFORE	
00-713-M	U.S.S.N. 09/693,352 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFORE	U.S. Patent No. 6,417,340, issued 7/9/02
00-714-G	U.S. 09/830,620 Filed 8/15/01	Mirkin, Nguyen/ NANOPARTICLES WITH POLYMER SHELLS	PENDING
00-715-A	U.S. 09/760,500 Filed 1/12/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	ALLOWED
00-1085-A	U.S.S.N. 09/820,279 Filed 3/28/01	Mirkin, Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	ALLOWED
00-1086-A	U.S. 09/903,461 Filed 7/11/01	Letsinger, Garimella/ METHOD OF DETECTION BY ENHANCEMENT OF SILVER STAINING	U.S. Patent No. 6,602,669, Filed 8/5/03
01-565-A	USSN 10/125,194 Filed 4/18/02	Mirkin, Nguyen, Watson, Park/ OLIGONUCLEOTI DE-MODIFIED ROMP POLYMERS AND CO-	PENDING

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		POLYMERS	
01-599-A	U.S.S.N. 10/291,291 Filed 11/08/02	Storhoff/NOVEL THIOL-BASED METHOD FOR ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES	PENDING
01-661-A	U.S.S.N. 10/034,451 Filed 12/28/01	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-661-C	U.S.S.N. 10/153,483 Filed 5/22/02	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-661-E	U.S.S.N. 10/397,579 3/26/03	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-1565-A	U.S.S.N. 10/266,983 Filed 10/08/02	Park, Taton, Mirkin/ARRAY- BASED ELECTRICAL DETECTION OF DNA USING NANOPARTICLE PROBES	PENDING
01-1705-A	U.S.S.N. 10/108,211 Filed 3/27/02	Nam, Park, Mirkin/BIO- BARCODES BASED ON OLIGONUCLEOTI DE-MODIFIED NANOPARTICLES	PENDING
02-338-B	USSN 10/172,428 Filed 6/14/02	Cao, Jin, Nam, Mirkin/MULTIHA NNEL DETECTION USING NANOPARTICLE PROBES WITH	PENDING

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		RAMAN SPECTROSCOPIC FINGERPRINTS	
02-338-C	10/431,341 5/7/03	Cao, Jin, Nam, Mirkin/MULTICHA NNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING